

REMARKS

The above amendments to the above-captioned application along with the following remarks are being submitted as a full and complete response to the Office Action dated March 20, 2006. In view of the above amendments and the following remarks, the Examiner is respectfully requested to give due reconsideration to this application, to indicate the allowability of the claims, and to pass this case to issue.

Status of the Claims

Claims 2-10, 12-15 and 17 are under consideration in this application. Claims 1, 11 and 16 are being cancelled without prejudice or disclaimer. Claims 3-4, 6-10 and 13-14 are being amended, as set forth in the above marked-up presentation of the claim amendments, in order to more particularly define and distinctly claim applicants' invention.

All the amendments to the claims are supported by the specification. Applicants hereby submit that no new matter is being introduced into the application through the submission of this response.

Allowed Subject Matter

Claims 2, 5, 12, 15 and 17 were allowed. Since claims 3-4, 6-10 and 13-14 are being amended to depend from the allowed claim 2 or claim 12, they are in condition for allowance.

Prior Art Rejections

Claims 1, 4, 6-11, 14 and 16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hasegawa et al. (US Pat. No. 5,912,531) in view of Sarrasin (US Pat. No. 5,600,343), and claims 3 and 13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sarrasin '343.

Since claims 1, 11 and 16 are being cancelled without prejudice or disclaimer, and claims 3-4, 6-10 and 13-14 are being amended to depend from the allowed claim 2 or claim 12, the relevant rejections thus become moot.

Double Patenting Rejections

Claims 1-17 were rejected under judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-25 of US Pat. No. 6,873,309 (assigned to Hitachi, Ltd.) as well as over claims 1-27 of US Pat. No. 6,608,620 (assigned to Hitachi, Ltd.).

Regarding US Pat. No. 6,873,309 (hereinafter “ the’309 patent”), Applicants strongly but respectfully contend that the Examiner only asserted that the relevant claims recited some non-patentably distinctive paragraph and the claim of the currently application was broader than the patented claim, but failed to properly establish the basis of the double patenting rejection.

The current application claims a broader invention than the ‘309 patent. A patented claim of a narrower combination of elements, for example, A + B + C + D, does not exclude the patentability of a boarder combination claim reciting A + B + C, as long as there was no prior art teaching the combination of A + B + C. In relation to the present application, the independent claims of the ‘309 patent recite one additional limitation D wherein “in an interval for shifting said one of the first lines in the selection state to the nonselection state of the high impedance state, said first drive unit sets said one of the first lines in the selection state to a nonselection level potential of a lower impedance as compared with the high impedance state” (e.g., last paragraph of claim 1 of ‘309 patent), which makes that limitation in combination with the other elements claimed patentably distinct form the combination claimed in the current application (which excludes the above-noted limitation). Since the Examiner failed to cite any prior art teaching that shows the combination recited in the currently application, there is no basis upon which the examiner can assert that one skilled in the art would be motivated to eliminated the above-noted limitation from the patented claim to embody the invention as claimed in the current application. Rather, Applicants will contend that the examiner has used his knowledge of the current application as a blueprint for this rejection. It is well established that a rejection based on hindsight knowledge of the invention at issue is improper.

Applicants respectfully contend that the Examiner is required under MPEP 804 II B 1. (quoted as follows) to apply the same standard of obviousness under 35 U.S.C. §103 to both a prior art rejection and to an obviousness-type double patenting rejection in order to explain why the claims of the currently application would have been obvious in view of claim 1 of the ‘309 patent.

Since the analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 U.S.C. 103(a) rejection, the factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103 are employed when making an obvious-type double patenting analysis.

In absence of such explanation, the Examiner has fallen short of establishing a proper basis of rejection. Consequently, the withdrawal of this outstanding double patenting rejection is in order, and is therefore respectfully solicited.

Applicants would like to point out that the current application duly entered into the US via PCT and claimed the priority date of a Japanese application date as early as September 9, 1999 which is earlier than the US filing date of Feb. 21, 2001 of the '309 patent such that the '309 patent cannot and does not constitute prior art against the current application.

Regarding US Pat. No. 6,608,620 (hereinafter "the '620 patent"), Applicants contend that the independent claims of the application recite a distinctive limitation of "said first driving means sets the first electrode held in a non-selected state to a state of having an impedance higher than that of the first electrode held in a selected state" and "said second driving means sets the second electrode held in a non-selected state to a state of having an impedance higher than that of the second electrode held in a selected state" that are absent from claims of the '620 patent. Accordingly, the withdrawal of this outstanding double patenting rejection is in order, and is therefore respectfully solicited.

Conclusion

In view of all the above, clear and distinct differences as discussed exist between the present invention as now claimed and the prior art reference upon which the rejections in the Office Action rely, Applicants respectfully contend that the prior art references cannot anticipate the present invention or render the present invention obvious. Rather, the present invention as a whole is distinguishable, and thereby allowable over the prior art.

Favorable reconsideration of this application is respectfully solicited. Should there be any outstanding issues requiring discussion that would further the prosecution and allowance

of the above-captioned application, the Examiner is invited to contact the Applicants' undersigned representative at the address and telephone number indicated below.

Respectfully submitted,

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